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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,678	01/27/2004	Mark D. Tucker	SD-7463	9818

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EXAMINER	
ANTHONY, JOSEPH DAVID	
ART UNIT	**PAPER NUMBER**
1714	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/765,678	TUCKER ET AL.	
	Examiner	Art Unit	
	Joseph D. Anthony	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/10/2006 as an amendment and RCE*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION AFTER FILING OF RCE

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-4, 6-7 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakagawa et al US Patent Number 3,901,819.

Nakagawa et al. teach a composition for activating an inorganic peroxide bleaching agent comprising (A) an acetic acid ester of a monosaccharide, a

disaccharide, a sugar alcohol, an internal anhydride of a sugar alcohol, or erythritol, said ester having at least 2 ester groups on the adjacent carbon atoms, and (B) an acetic acid ester of a polyhydric alcohol having a melting point not higher than about 30.degree.C., the weight ratio of the components being within the range of from 1/9 to 9/1. These are O-acetyl type bleach activators. Nakagawa et al also teaches the conventional use of low water soluble tetracetyl ethylene diamine (TAED) which is a N-acetyl type bleach activator, see abstract, column 2, lines 1-65, Tables, and claims. Applicant's claims are deemed to be anticipated over the dry composition set forth in example 3 when it is added to water. In the alternative, applicant's invention is deemed to be obvious over Nakagawa et al since it would have been obvious to add the dry composition of example 3 to water since such a step is disclosed by the reference as how all the dry compositions are to be used for bleaching.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa et al US Patent Number 3,901,819 in view of Huth et al. U.S. Patent Number 6,448,062.

Nakagawa et al. has been described above. This rejection builds on the rejections made above. Nakagawa et al. differs from applicant's claimed invention in that there is no direct disclosure to the further addition of polyol drying agents such as sorbitol.

Huth et al. teach a composition for simultaneous cleaning and decontaminating a device. The composition is a per-compound oxidant in an amount effective for decontaminating the device and an enzyme in an amount effective for cleaning the device. The device may be a medical device such as an endoscope or kidney dialyzer and a plurality of devices can be cleaned

using the same composition. The composition may additionally contain a corrosion inhibitor in an amount effective to prevent corrosion of a metal, a chelator, a buffer, a dye and combinations thereof, see abstract, examples and claims. Huth et al directly discloses that it is well known in the art to use polyols, such as sorbitol, as drying agents in decontamination compositions, see column 20, lines 26-41.

It would have been obvious to one having ordinary skill in the art to use the disclosure of Huth et al to polyol drying agents for decontamination formulations as motivation to actually added polyols, such as sorbitol, to the decontamination formulations taught by Nakagawa et al. for the benefits that such drying agents would effect in said decontamination formulations.

Response to Arguments

5. Applicant's arguments filed 10/10/2006 with the amendment and Request For A Continuation Application (i.e. RCE) have been fully considered but are not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth next.

Applicant's "arguments?" for patentability over Nakagawa et al. U.S. Patent Number 3,901,819 are not well taken. The fact that Nakagawa et al.'s aqueous bleaching composition requires the present of both component (A) and (B) (wherein component (B) reads directly on applicant's claimed water-soluble bleaching activator), in no way patentably distinguishes Nakagawa et al's bleaching composition from applicant's claimed decontamination formulation for the following reasons: 1) Nakagawa et al' disclosed aqueous bleaching formulations comprise all of applicant's claimed components except for the polyol compound of claim 5, 2)

applicant's claims use the claim language of "consisting essentially of" in the preambles of independent claims 1, 4, 6 and 7 which is defined by the Court to: "limits the claims to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention, see In re Herz 537 F.2d 549, 551-52. 190 USPQ 461.463 (CCPA 1976). The MPEP is very clear in section 2111.03 on "Transitional Phrases" that: "For the purposes of searching for and applying prior-art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to 'comprising'.". As such, applicant's claims are not deemed to exclude Nakagawa et al's additional components such as Nakagawa et al's component (A), and 3) applicant's have set forth no showing of any superior and unobvious results for applicant's claimed formulations that do not require Nakagawa et al's component (A). In fact Nakagawa et al directly discloses that the present of both component (A) with component (B) greatly enhances the activating effect of the activator with the peroxy bleach component. One having ordinary skill in the art would thus expect that Nakagawa et al's composition would have a superior activating effect on the peroxy compound than would applicant's claimed composition which does not require (but does not exclude) the present of Nakagawa et al's component (A).

Finally applicant's Terminal Disclaimers have been approved by the PTO.

Examiner Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571)

272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

11/12/06